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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,032	07/30/2003	Anthony Cox	31045-19	7770

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Mitchell, Silberberg & Knupp, LLP  
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Los Angeles, CA 90064

EXAMINER

KAVANAUGH, JOHN T

ART UNIT PAPER NUMBER

3728

DATE MAILED: 08/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/630,032

Applicant(s)

COX ET AL.

Examiner

Ted Kavanaugh

Art Unit

3728

**– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 1-15 and 25-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7-30-2003.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 1-15 have withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3-23-2006.
2. With respect to the election of species, which was traversed, the examiner called up the applicant (Mr. Joseph Swan) to discuss this. A new species is as follows:
3. This application contains claims directed to the following patentably distinct species:

Species I: The Method as shown in figures 6,7A and 7B

Species II: The method as shown in figures 8,9A and 9B

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 16 appears to be generic. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after

Art Unit: 3728

the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a).

4. During a telephone conversation with Joseph Swan on July 25, 2006 a provisional election was made with traverse (applicant actually didn't say with traverse or without traverse) to prosecute the invention of Species I, claims 16-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 25-32 have withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 112***

6. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The examiner has reviewed the specification but cannot determine what the "preformed piece of second durable material" is and therefore the claim is not clear.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 16-19 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by US 2003/0121179 (Chen).

Chen teaches a method of forming the bottom portion of the shoe as claimed (see figures 3-4 )including the steps of placing a perforated textile material (3A, see paragraph #18) having perforated (33A) holes greater than 0.5 millimeters (see paragraph #19) in a mold (51), inserting a durable material (2) composed of natural rubber (see paragraph #16) on top of the perforated material and causing the durable material to harden into a solid form (see paragraph #18). The durable material is naturally more durable than the textile material.

9. Claims 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by US 4899467 (Mackey).

Mackey teaches a method of forming the bottom portion of the shoe (see figures 1-6) as claimed including the steps of placing a perforated material (46, see paragraph #18) having perforated (33A) holes greater than 0.5 millimeters (see figure 4) in a mold,

Art Unit: 3728

inserting a durable material (28,42) composed of PVC and the like (see col. 3, lines 33-39) on top of the perforated material and causing the durable material to harden into a solid form (see col. 4, lines 4-10). The durable material is naturally more durable than the textile material.

10. Claims 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6032388 (Fram).

Fram teaches a method of forming the bottom portion of the shoe as claimed (see figures 3) including the steps of placing a perforated material (9) having perforated holes greater than 0.5 millimeters in a mold (51), inserting a durable material (11) on top of the perforated material and causing the durable material to harden into a solid form. The durable material is naturally more durable than the textile material.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over any of the following: Fram '388, Mackey '467 and Chen '179.

Fram, Mackey and Chen all teach the method as claimed except for the perforated material being a plural pieces of perforated material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to

Art Unit: 3728

construct the single perforated material out of a plural pieces of perforated material, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Moreover, if you have a shoe with a heel extending from the outsole you would naturally have two pieces.

13. Claims 21 and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Chen '179.

Chen teaches a method as claimed (see the rejection above) except for the textile material being a cloth (claim 21) and the perforated material (cloth/textile material) being multi-colored. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the textile material out of cotton, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding the perforated material being multi-colored, it would have been obvious to construct the perforated textile material as taught above with any appropriate change in appearance such as a designated color or multi-color inasmuch as there is no functional relationship of the color of the footwear and the structure of the footwear. It would be an obvious design choice to construct the footwear with any desired color to provide a pleasing appearance to the wearer.

Art Unit: 3728

14. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over the reference(s) as applied to claim 16 above, and further in view of US Re. 35,905 (Vincent et al).

Vincent teaches placing a wrap (32) in a mold (54) prior to forming the outsole; see figure 5 and col. 6, lines 21-36. It would have been obvious to provide the method as taught above with the prior step of inserting a wrap (preformed piece of a second durable material) in to the mold, as taught by Vincent, to provide an ornamental detailed design on the side of the shoe sole.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

16. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including:

-“The reply must present arguments pointing out the *specific* distinctions believed to render the claims, including any newly presented claims, patentable over any applied references.”

--“A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.”


-Moreover, “The prompt development of a clear issue requires that the replies of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06” MPEP 714.02. The “disclosure” includes the claims, the specification and the drawings.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). Other useful information can be obtained at the PTO Home Page at [www.uspto.gov](http://www.uspto.gov).

In order to avoid potential delays, Technology Center 3700 is encouraging FAXing of responses to Office Actions directly into the Center at (571) 273-8300 **(FORMAL FAXES ONLY)**. Please identify Examiner Ted Kavanaugh of Art Unit 3728 at the top of your cover sheet.

Any inquiry concerning the MERITS of this examination from the examiner should be directed to Ted Kavanaugh whose telephone number is (571) 272-4556. The examiner can normally be reached from 6AM - 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on (571) 272-4562.

  
Ted Kavanaugh  
Primary Examiner  
Art Unit 3728

TK  
July 26, 2006